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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

GRAYSAY, TAMARA L

ART UNIT PAPER NUMBER

3623

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/734,793

Applicant(s)

JANISZEWSKI, STEPHEN

Examiner

Tamara L. Graysay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Priority

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

2. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 1-13 of this application.

Namely, the invention as claimed in the instant application is not disclosed in the prior provisional application 60/176421, filed 14 January 2000. For example, the provisional application does not disclose the claim 1 method step of transmitting requirements from a contractor system over a communication network or the claim 10 means for displaying the requirements.

Moreover, the prior provisional application disclosure as a whole is not sufficient to comply with 35 U.S.C. 112 insofar as the steps of the method and the elements of the apparatus claimed in the instant application are not be described in sufficient detail for one of ordinary skill in the art to make and/or use the invention as claimed in the instant application. For example, the

provision application does not disclose how to make and/or use the claim 2 method step of determining whether a bidder is a registered user; or the claim 10 means for generating a bid record along with historical metric data information.

Information Disclosure Statement

3. The information disclosure statement filed 28 February 2002 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "181" has been used to designate both END (Figure 2) and PERFORM CONTINUOUSLY OR PERIODICALLY SOFTWARE METRIC PROCESSING DURING DEVELOPMENT OF SOFTWARE PRODUCT (Figure 6). The Examiner recommends that "181" in Figure 2 be changed to 190, as recited in the specification at p.16, last line. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

uncertainty of the scope of the claim. *For purpose of this Office action, claim 3 has been interpreted as including the step of creating a new account for the bidder.*

b. Regarding claim 4, the conditional statement “if the bidding period has expired” is unclear whether the claim is further limiting the parent claims, and what the scope of the executing step is when the bidding period has not expired. *For purpose of this Office action, claim 4 has been interpreted as including the step of communicating the award of the bid.*

c. Regarding claim 6, the conditional statement “if necessary” is unclear because the potential alternatives can vary considerably and one of ordinary skill would not understand when it would be necessary to “clarify [the requirements] to that bidder” in the context of the claim. The use of the conditional statement without any further explanation or description of what would render the clarifying step to be “necessary” renders the claim indefinite. *For purpose of this Office action, claim 6 has been interpreted as including the step of clarifying the requirements.*

d. Regarding claim 7, the conditional statement “if required” is ambiguous because the scope of the claim cannot be ascertained, i.e., whether the communicating step includes “communicating ... modifications ... to that bidder” or not. One of ordinary skill in the art would not be able to determine whether modifications to the requirements are required, as claimed. The claim is rendered indefinite due to the conditional statement. *For purpose of this Office action, claim 7 has been interpreted as including the step of modifying the requirements to the bidder.*

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "172" (Figure 5). Corrected drawing sheets, or amendment to the specification to add the reference character(s) in the description, are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

6. Claim 11 is objected to because of the following informalities: line 1, "bidder" should be --bidding--, for consistency with claim 10. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 3-9 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Regarding claim 3, the conditional statement "if the bidder ... is not a registered user" is unclear whether the claim is further limiting the parent claims when the bidder is a registered user. Thus, the conditional statement renders the claim indefinite due to the

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e. Regarding claim 11, the compound recitation of means for storing ... data for monitoring ... performance is unclear whether the means is capable of performing both functions or if there are separate means for performing each function, storing and monitoring. Generally, a means for storing data is not necessarily capable of also performing the function of monitoring, therefor the claim language is indefinite as to the metes and bounds of patent protection sought. It is not evident from the instant application that there is a single means for performing both functions. *For purpose of this Office action, claim 11 has been treated as a means for storing data and that stored data would be available, broadly, to monitor performance.*

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-3, 5, 10-13, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Walker (US-5862223).

a. Regarding claim 1, Walker discloses a method for electronically conducting a bidding transaction comprising the steps:

- transmitting bid requirements over the network;

Walker discloses a method including the step of an end user creating a bid requirement (user request Ref.120 and method step depicted in Fig.30, Ref.3000) and transmitting the bid requirement over the network (via central controller Fig.30, Ref.3010; also discussed at C.7, L.30-32 and Ref.120 C.17, L.13-35).

- controlling bidder system to display the bid requirements;

The Walker method inherently includes the step of controlling the bidder system to display the bid requirements as exemplified in Fig.30, Ref.3020. Moreover, Walker discloses a bidder display at Ref.425. It is inherent that the display would be presented as a result of the step of controlling the bidder system.

- sending bid with identifier over the network;

The Walker method includes sending a bid as depicted in Fig.30, Ref.3040.

Walker discloses that the step of sending the bid includes identifier of the bidder insofar as the end user can choose from the bids that are offered, C.37, L.60-63.

- retrieving historical data; generating a bid record with historical data; and communicating the bid and historical data to the contractor.

The Walker method includes the step of retrieving historical data about the bidder insofar as the contractor may review expert qualifications, C.7, L.59-67, before accepting the bid record (bid offer). Further, Walker depicts the step of communicating the bid record (bid offer) and historical data to the contractor in Fig.30, Ref.3050.

The preamble statement of intended use “for a software item” has been given no patentable weight in the method claim because the software item is merely functionally recited and the method of electronically conducting a bidding transaction as claimed in claim 1 can be performed without the particulars of the software item. Further, the term “software requirements definition identifying the software item to be developed” recited in the body of the claim is nonfunctional descriptive material that is merely read or output

by the computer, no functional interrelationship with the process is claimed. Therefore, the limitation has been treated as a bid requirement, not specific to software development.

b. Regarding claim 2, Walker discloses the step of determining whether a bidder is a registered user at C.8, L.29-32.

c. Regarding claims 3 and 5, Walker discloses the steps of creating a new account including receiving personal data (detailed application and list of references C.8, L.17-28), storing the personal data (the central controller Ref.200 stores the data), confirming the new account (applicant is accepted or rejected C.8, L.22), and creating historical data (detailed application and list of references C.8, L.17-28; expert qualifications Ref.140, C.18, L.6-30).

d. Regarding claims 10-13, Walker discloses an apparatus including

- i. a contractor system (Ref.500) connected to a network (Ref.200);
- ii. a bidder system (Ref.400) connected to the network and including means (display Ref.425) for displaying bid requirement information from the contractor system;
- iii. a central server (Ref.200) including a requirement database (Ref.265), means for storing historical data (Ref.275, 280, 285, 297), means for generating a bid and historical data (Ref.270);
- iv. means for storing data (Ref.250);

The particular type of data or the frequency of collection is not positively recited in the apparatus claim. Walker discloses a means for storing data as depicted by Ref.250. And as such the stored data would be available,

as broadly recited, to somehow monitor performance based on the stored data.

- v. an account database (Ref.255);
- vi. a plurality of contractor systems and a plurality of bidder systems (see C.26, L.31-35).

The statement of intended use "for a software item to be developed" in the preamble of claim 10 has not been given patentable weight because the structure of the claimed apparatus does not require a software item to be developed. The software requirement information identifying the software item in the body of claim 10 does not impart any meaning to the positively recited structural limitations of the apparatus claim because the information is not positively claimed, i.e., the body of the claim does not depend on the preamble recitation of the software item for completeness.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 4 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US-5862223) in view of Gindlesperger (US-6397197).

- a. Regarding claim 4, Walker discloses the steps:
 - i. determining whether bidding period has expired (C.7, L.30-31);

- ii. executing bidder selection process (Fig.30, Ref.3060, 3070; bid acceptance C.8, L.1-16).

Walker lacks executing ongoing project metric data collection. Gindlesperger teaches the step of monitoring job progress (C.5, L.49-52) as a tool to compare the successful bidder's progress with project milestones thereby evaluating the successful bidder's work product. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Walker to include the step of executing ongoing project metric data collection, as suggested by Gindlesperger, in order to more accurately evaluate the selected bidder's progress.

- b. Regarding claim 6, Walker discloses the executing step includes the steps:
 - i. determining if bidder has questions (see C.26, L.22-57);
 - ii. clarifying requirements (see C.26, L.22-57);
 - iii. estimating a bid (bid offer Ref.165);
 - iv. receiving a bid (bid offer sent to central controller Ref.200);
 - v. recording the bid (central controller cumulates bids as discussed at C.37, L.54-60).
- c. Regarding claim 7, Walker further discloses the clarifying step (real-time communication embodiment) includes the steps:
 - i. displaying questions (video monitor Ref.430);
 - ii. communicating answers (Ref.130).

Walker's clarifying step is disclosed as the contractor questions (Ref.140) that are answered by the bidder (130) but is silent as to the bidder (expert) posing questions to the

contractor (end user). The examiner takes official notice that in the request for bid art, it is known that an initial request for bid would generate questions in response in order to clarify the scope of the request for bid. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Walker and Gindlesperger combination to include questions from either party in a back-and-forth as well as one-way communication through the network in order to fully utilize the communication aspect of Walker. For example the expert may request a clarification to the end user's question by posing a question himself. This process occurs often in communications between bidders and contractors.

d. Regarding claim 8, the motivation to combine Walker and Gindlesperger is discussed with respect to claim 4 in paragraph 12.a, above. Walker, as modified by Gindlesperger, discloses the executing bidder selection steps include the steps:

- i. estimating the cost of requirements (Walker- bid offer Ref. 165);
- ii. communicating bid and historical data to contractor (Walker- see C.7, L.58-61; Fig.30, Ref. 3050);
- iii. receiving selection of successful bidder (Walker- see Fig.30, Ref.3070);
- iv. creating current project metrics data (Gindlesperger- project milestones C.5, L.49-52).

13. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US-5862223) and Gindlesperger (US-6397197) as applied to claim 4 above, and further in view of Hevner (article, Phase containment metrics for software quality improvement).

Walker, as modified by Gindlesperger, lacks the steps recited in claim 9. Hevner teaches performing metrics data collection, recording collected metrics data, and communicating the metrics to users in order to produce higher quality projects and enhance productivity. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Walker and Gindlesperger to include performing metrics data collection, recording collected metrics data, and communicating the metrics to users, as recited in claim 9, in order to produce higher quality projects and enhance productivity of the project.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Sheth (US-2002/0026398) discloses a method and system for electronic bidding for services.
- Bukow (US-6567784) discloses a method and system for registering bidders and electronic bidding for projects.
- Kou (US-6363365) discloses a bidding period (close of tendering).
- Harrington (US-6161099) discloses a method and system for creating accounts (C.6, L.66 - C.7, L.2) and bidding period (C.10,L.32).
- de la Motte (US-2003/0014318) discloses a method and system including controlling bidder system to display requirements (P.0043); and, communicating bid to contractor (buyer) system (P.0046).

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- Aycock (US-5765138) discloses a method and system for evaluating bidders and collecting historical data about bidders.
- Tsutagatani (JP-2002041603-A) discloses a method and system for recording bids and selecting bidder for a project.
- Article, Bidding to be best, discloses a software package for estimating a bid.
- Callahan discloses managing a software project using metrics.
- McQuaid discloses collection of a complexity metric throughout software development as a project management, software testing, and software maintenance tool that provides feedback.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is (703) 305-1918. The examiner can normally be reached on Monday - Friday from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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